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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/019,287

01/02/2002

Yasuyuki Kawahara

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03/01/2006

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EXAMINER

OH, TAYLOR V

ART UNIT

PAPER NUMBER

1625

DATE MAILED: 03/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/019,287

Applicant(s)

KAWAHARA ET AL.

Examiner

Taylor Victor Oh

Art Unit

1625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 November 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 6-11, 19-30 and 34-88 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 6-8, 10, 11, 19-26, 28-30, 34-39, 41-51, 53-59, 61-71, 73-81 and 83-88 is/are rejected.
- 7) ☒ Claim(s) 9, 27, 40, 52, 60, 72 and 82 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 11/14/05&1/4/06.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/14/05 has been entered.

The Status of Claims :

Claims 6-11 ,19-30, and 34-88 are pending.

Claims 6-8, 10-11 ,19-26, 28-30, 34-39, 41-51, 53-59, 61-71, 73-81, and 83-88 have been rejected.

Claims 9, 27, 40, 52, 60, 72, and 82 have been objected.

DETAILED ACTION

Priority

1. This application is a 371 of PCT/JP00/04838 filed on 07/19/2000.

Drawings

2. None.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 6-8, 10-11, 19-26, 28-30, 34-39, 41-43, 44-51, 53-59, 61-63, 64-71, 73-75, 76-81, 83-88, are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a sulfur-free and phosphorous-free catalyst, such as tetra(C₃-C₈ alkyl)titanate, titanium oxide, titanium hydroxide, sodium alkoxide of 1 to 4 carbon atoms, sodium hydroxide, C₃-C₁₂ fatty acid tin salt, tin oxide, tin hydroxide, zinc oxide, zinc hydroxide, lead oxide, lead hydroxide, aluminium oxide and aluminum hydroxide, does not reasonably provide enablement for all the sulfur-free and phosphorous-free catalyst in the field of the organic and inorganic chemistry. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to include all the catalyst unrelated to the invention commensurate in scope with these claims.

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Furthermore, the instant specification fails to provide information that would allow the skilled artisan to practice the instant invention without undue experimentation.

Attention is directed to *In re Wands*, 8 USPQ2d 1400 (CAFC 1988) at 1404 where the court set forth the eight factors to consider when assessing if a disclosure would have required undue experimentation, citing *Ex Parte Forman*, 230 USPQ 546 (BdApls 1986) at 547 the court recited eight factors:

- 1) the quantity of experimentation necessary,
- 2) the amount of direction or guidance provided,
- 3) the presence or absence of working examples,
- 4) the nature of the invention,
- 5) the state of the prior art,
- 6) the relative skill of those in the art,
- 7) the predictability of the art, and
- 8) the breadth of the claims.

In the instant case, the claim encompasses various catalysts. However, applicants' specification provide only three exemplified catalysts ,tin hydroxide, tin oxide ,and tetraisopropyl titanate in the examples. Furthermore, the catalyst compositions represent an unpredictable aspect in the art of organic chemistry . See *Exparte Sizto*, 9 USPQ2d 2081 (Bd. Of App. And Inter. March 1988). Thus, the specification herein have failed to provide sufficient working examples to support the use of various catalysts. Therefore, an appropriate correction is required.

Applicants' Argument

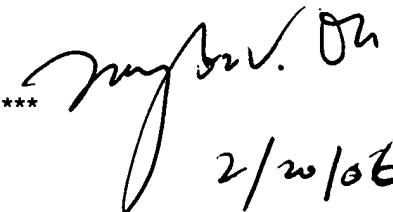
1. None of the prior art disclose the preparation of alicyclic dicarboxylic acid diester.

With respect to the applicants' argument, the examiner agrees.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Taylor Victor Oh whose telephone number is 571-272-0689. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cecilia Tsang can be reached on 571-272-0562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


2/20/06